

Examiner, should the Examiner reconsider. Applicants earnestly solicit the cooperation of the Examiner and his supervisor in bringing this prosecution to conclusion.

Claims 20-32 are pending in this application. The Office Action, on page 2, renews precisely the rejection of claims 20, 21, 23, 28, 29 and 32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,982,538 to Shikama et al. (hereinafter "Shikama") and further in view of U.S. Patent No. 5,651,599 to Fujimori et al. (hereinafter "Fujimori") with the caveat, as best the Examiner is able to ascertain. Applicants understand that this caveat pertains to previously enumerated rejections under 35 U.S.C. §112, second paragraph, where the previous Office Action indicated that the language of claim 20 introduced indefiniteness. Because the §112 rejections have been overcome (see the January 21 Examiner's interview summary record and the current Office Action), Applicants do not understand why, this caveat remains in the Office Action. Applicants understand that the claims are definite. If the Examiner disagrees, he is requested to specifically point out the allegedly unclear points.

A. Shikama Does Not Teach Or Suggest All Of The Features Of Claim 20 The Office Action Alleges

- 1. Shikama Does Not Disclose "a transparent plate bonded to and in contact with substantially an entire at least one surface of the plurality of optical modulation devices"**

The Office Action, as was the previous Office Action, is laborious in attempting to map features disclosed in Shikama to the features recited in at least independent claim 20. As Applicants argued previously, despite the assertions to the contrary in the Office Action, Shikama cannot reasonably be considered to teach, or to have suggested, a transparent plate bonded to and in contact with substantially an entire at least one surface of the plurality of optical modulation devices. In asserting that these features are taught or at least suggested by Shikama, the Office Action is internally incongruous.

In the third and fourth lines on page 3 of the Office Action, it asserts that Shikama teaches a plurality of optical modulation devices [Shikama, Fig. 1, 6R, 6G, 6B]. These devices are shown in greater detail in Fig. 2. The Office Action then selectively separately references the exploded view of the light modulation device (Fig. 2) to allegedly disclose the separate feature of a transparent plate bonded to and in contact with substantially an entire at least one surface of the plurality of the optical modulation devices. The Office Action, in asserting that the optical modulation devices are elements 6 shown in Fig. 1, cannot then take portions of elements 6 and assert that they are separate features as recited in the claims. To do so would require improperly construing the claims so as to vitiate, or otherwise read out, a positively recited feature of the claims.

It is a long-standing principle of patent law that claim language cannot be construed in a manner that would vitiate or otherwise render moot a positively recited claim term. It is precisely this guidance that the Office Action improperly ignores in asserting on the one hand that elements 6 allegedly comprise the light modulation devices, but then asserting that portions of elements 6 are allegedly connected to elements 6 in order to find suggested all of features recited in the claims. Finding such a suggestion of this feature in Shikama can only be arrived at through a strained attempt to map the positively recited claim terms to features disclosed in the invention of Shikama employing impermissible hindsight reasoning based on the road map provided by Applicants' disclosure.

2. Figure 1 of Shikama Cannot Be Unreasonably Broadly Construed For What It Allegedly Depicts

There is also nothing in Shikama that can reasonably be considered to have suggested a plurality of fixed frame plates that hold at least one of the plurality of optical modulation devices or at least one of the plurality of optical modulations devices and transparent plates, each mounting frame plate being detachably fixed to at least one of the plurality of fixed

frame plates. It is simply unreasonable to view Fig. 1 of Shikama, or anything else in the disclosure of Shikama, to teach or to have suggested this combination of features. There is nothing to suggest how the optical modulation devices of Shikama are precisely held in place. In this regard, it is not reasonable to assert that they must be held in place by the combination of fixed frame plates and mounting frame plates detachably fixed to at least one of the plurality of fixed frame plates, as positively recited in the claims. In fact, the Office Action makes no attempt whatsoever to specifically point out which elements shown in Fig. 1 of Shikama are alleged to correspond to fixed frame plates and mounting frame plates detachably fixed to at least one of the plurality of fixed frame plates.

For at least the above reasons, the conclusion on page 3 of the Office Action that "Shikama discloses the elements of instant claim as noted above" necessarily fails. It would take an unreasonable and overly broad interpretation of the disclosure and Fig. 1 of Shikama, for at least the reasons noted above, to conclude that the enumerated elements are arguably shown. As such, this conclusion, on its face, is incorrect and unsupportable.

3. The Office Action Misquotes And Mischaracterizes Claim Features

The Office Action, in fact, misquotes the features as recited in the claims. Claim 20 recites, among other features, a transparent plate bonded to and in contact with substantially an entire at least one surface of at least one of the plurality of optical modulation devices; a plurality of fixed frame plates in a fixed contact with each light incident surface of the prism and a plurality of mounting frame plates that hold at least one of the plurality of optical modulation devices or at least one of the plurality of optical modulation devices and transparent plates, each mounting frame plate being detachably fixed to at least one of the plurality of fixed frame plates. The Office Action, misquotes the language of claim 20, mixing the plurality of fixed frame plates and the plurality of mounting frame plates, and does

not even address the feature of a plurality of fixed frame plates in a fixed contact with each light incident surface of the prism. As such, even if it were arguable that Shikama disclosed all of the elements of the instant claim as the Office Action sets them out, the Office Action errs in not addressing all of the features recited in claim 20.

B. Fujimori Does Not Include The Features Accessed Not To Be Taught By Shikama

The Office Action admits that Shikama fails to disclose a plurality of mounting frame plates that hold the optical modulating device, and the transparent plate, each mounting frame plate being detachably fixed to each fixed frame plate. Here, the Office Action again misquotes the language positively recited in the claims. As such, the rejection fails on its face.

The Office Action asserts, that Fujimori discloses a plurality of mounting frame plates that hold optical modulation devices and other optical elements each mounting frame plate being detachably fixed to each fixed frame plate, citing the depiction in Fig. 10 of Fujimori. Disregarding for the moment that the claim elements are misquoted, even a broad interpretation of the depiction in Fig. 10 cannot reasonably be considered to teach, or to have suggested, that the depicted plurality of mounting frame plates that are alleged to be shown in Fig. 10 are in any way detachably fixed to at least one of a plurality of fixed frame plates as is positively recited in the claims. The Office Action, in fact, simply states this as a conclusion but makes no attempt to differentiate, for example, in Fig. 10 between what are alleged to be mounting frame plates and what are alleged to be fixed frame plates to which the mounting frame plates may be detachably fixed.

C. The Combination Of Shikama And Fujimori Would Not Have Been Obvious

In addition to the fact that not all of the elements can reasonably be considered to be shown in either of the applied prior art references for the reasons indicated above, the Office

Action errs in its further analysis asserting that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shikama to include a plurality of mounting frame plates that hold optical modulation devices as taught by Fujimori for the purpose of securing the optical device to the lower chassis concluding that the skilled artisan would have been motivated to improve the invention of Shikama per the above such that the optical elements would remain securely in position even if excessive force is applied to the outer case of a liquid crystal video projector, a rationale provided in a discussion in Fujimori at col. 14, lines 27-33, in the description of Fig. 10.

Despite the assertions of the contrary in the Office Action, there is nothing to suggest this combination even given a broad reading of the teachings of both Shikama and Fujimori. Based on at least the widely diverse configurations between the Shikama projector and the Fujimori projector any alleged improvement of the Shikama device would reasonably have had to be centered around the prism, an element which is not shown at all in Fig. 10 of Fujimori. There is nothing in Shikama, in fact, to suggest that there is any concern regarding excessive force being applied, i.e., that the optical elements are not already securely held in place, nor is that a concern which the subject matter of the pending claims addresses. In other words, one of ordinary skill in the art when faced with an objective of attempting to limit deteriorating optical properties of the optical modulation element due to heat generation of the polarizer, even given the teachings of Shikama and Fujimori, would not have been motivated to combine these references in the manner suggested by the Office Action, and the alleged motivation to do so is simply not supportable based on the objective evidence provided in the prior art.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" See also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants respectfully submit that the rejection of at least independent claim 20 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references.

D. The Office Action Mischaracterizes, And Fails To Properly Address, Applicants Arguments

Applicants previously argued that Shikama cannot reasonably be considered to teach, or to have suggested, a plurality of fixed frame plates in a fixed contact with each light incident surface of the prism. This precise feature is still not even addressed in the current Office Action.

Additionally, Applicants noted in their reply to the previous Office Action that contrary to the assertions in the Office Action Applicants did not see where Shikama disclosed "fixed frame plates" in Fig. 1, as argued again above. In a footnote on page 6 of the February 28 Amendment, Applicants requested that "[s]hould the Examiner repeat this assertion, Applicants request a thorough explanation as to how Fig. 1 is believed to disclose this feature." The current Office Action fails to address (1) Applicants' specific argument or (2) Applicants' specific request. Rather, in response to Applicants' arguments, the current Office Action, at page 10, skips all of the above and responds only to Applicants' conclusion that Shikama, Fujimori, or a combination of these references, cannot reasonably be considered to teach, or to have suggested, the positively recited combination of features in at least independent claim 20.

The Office Action at the bottom of page 10 and the top of page 11 indicates that the Examiner is not persuaded by Applicants' arguments because the Examiner believes that he has mapped, element by element, the claimed features as recited in claim 20. For at least the reasons indicated above, this conclusion is not correct.

The admonition on page 11 of the Office Action is misplaced where it states "Furthermore, Examiner notes Rule 37 C.F.R. §1.111(b) requires Applicant to 'distinctly and specifically point out errors' in the Examiner's Action. Also, arguments or conclusions of Applicant cannot take the place of evidence." Applicants respectfully refer specifically back to page 6 of Applicants' February 28 Amendment in which Applicants positively asserted that "Shikama cannot be reasonably read to teach, or even to have suggested, a plurality of fixed frame plates in a fixed contact with each light incident surface of the prism" and in the footnote "the Office Action ... asserts that Shikama discloses 'fixed frame plates' in Fig. 1. Applicants disagree that Fig. 1 discloses 'fixed frame plates' as claimed. Should the Examiner repeat this assertion, Applicants request a thorough explanation as to how Fig. 1 is believed to disclose this feature." As such, Applicants specifically met the requirements of 37 C.F.R. §1.111(b) to distinctly and specifically point out errors in the Examiner's Action. That the Examiner mistakenly focused then on, and quoted in this Office Action, Applicants' conclusions without addressing the specific arguments that Applicants made is improper. Further, the implication that Applicants have somehow erred in their response in this regard is also improper and unsupportable based on at least the above. Burden cannot be shifted to the Applicants' to rebut arguments in circumstances where the Office Action fails to make a proper *prima facie* case for obviousness.

E. The Other Varyingly Applied References Do Not Overcome The Shortfalls Enumerated Above

The Office Action, on pages 5-10, varyingly rejects claims 22, 24-27, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over the combination of Shikama and Fujimori and further in view of U.S. Patent Nos. 3,910,682 to Arai et al. (hereinafter "Arai"), 4,751, 686 to Iwashita et al. (hereinafter "Iwashita"), 5,508,834 to Yamada (hereinafter "Yamada"), 5,399,850 to Nagatani et al. (hereinafter "Nagatani") and 5,806, 950 to Gale et al. (hereinafter "Gale"). These rejections are respectfully traversed.

None of the additionally applied prior art references discloses or suggests a combination of fixed frame plates and mounting frame plates as is specifically recited in independent claim 20. Applicants pointed this out in the February 28 Amendment as well.

None of these references overcome the shortfalls in the application of Shikama and/or Fujimori to at least the subject matter recited in claim 20. Therefore, claims 22, 24-27, 30 and 31 are also neither taught, nor would they have been suggested, by the varyingly applied combinations of the applied prior art references for at least the respective dependence of these claims directly or indirectly on independent claim 20, as well as for the separately patentable subject matter that each of these claims recites.

As noted above, this is precisely the argument that was made in support of the patentability of the enumerated dependent claims in the February 28 Amendment. In reply, on page 12 of the current Office Action, the Office Action states the Examiner is not persuaded. The Office Action incorrectly states that Applicants argued against, or otherwise attacked, the references individually. This conclusion is not correct. Applicants were very specific in pointing out that none of the additionally applied references overcame the shortfalls, as discussed in great detail above, in the application of the combination of Shikama and/or Fujimori to independent claim 20 from which these claims directly or indirectly

depend. As such, the varyingly applied combinations could not reasonably be considered to teach, or to have suggested, the subject matter recited in the enumerated claims. Applicants did not then, and do not now, attack the references individually. Rather, Applicants respectfully point out that the varying combinations of applied prior art references do not succeed in rendering obvious all of the features varyingly recited in the claims.

* * * *

Accordingly, reconsideration and withdrawal of the rejections of claims 20-32 under 35 U.S.C. §103(a) as being unpatentable over Shikama and Fujimori, taken as a combination, or in varying combinations with the other varyingly applied prior art references, are respectfully requested.

Further, Applicants respectfully request, under the provisions of MPEP §707.02, a personal interview with Examiner Leroux his Supervisory Patent Examiner, should any of the rejections of the Office Action be maintained.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 20-32 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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